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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/364,731	07/30/1999	RONALD A. KATZ	244/165	9809

7590 03/27/2003

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EXAMINER
WOO, STELLA L

ART UNIT	PAPER NUMBER
2643	17

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/364,731	Katz
Examiner	**Art Unit**
Stella Woo	2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Dec 26, 2002*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *29, 31-33, 35-39, 41-43, and 45-48* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *29, 31-33, 35-39, 41-43, and 45-48* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 26, 2002 has been entered.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 29, 31-33, 35-39, 41-43, 45-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 29, 31-33, 35-37 recite a "**telephone system**...of a type **controllable** by data related to cards" and claim 38 recites a "method of handling telephone calls...by use of data related to cards." However, applicant's specification contains no teaching or suggestion of using "cards" in the manner recited in the claims. A card having data for controlling a telephone

system is used by a caller to place a call over any phone and to charge the call to the account of the accountholder. A telephone system is a system which allows communication between two telephone terminals such that a card having data which controls a telephone system would have the effect of controlling the telephone connection. In contrast, applicant's specification describes the use of a credit card to authorize a transaction, such as mail order transaction or lottery participation, which takes place over an already completed telephone connection such that applicant's card does not control a telephone system. A card having data used for controlling a telephone system or handling telephone calls, as in the travel card of Marshall and as defined by the present claims, is used to authorize telephone call completion between a caller and a desired second party. The credit card or lottery ticket of the applicant is used to authorize a mail order transaction or participation in a lottery; calls are completed to applicant's telephone-interface system without any prior qualification based on the credit card or lottery identification data. Therefore, applicant's credit card or lottery ticket cannot be considered as a "card" as defined by the claims, which carries out a specific function in the telephony art. The card used in applicant's telephonic-interface system does not contain data which is used to control a type of telephone system. Rather, it is used to authorize a mail-order transaction or lottery participation.

Claims 29, 31-33, 35-37, 39, 41-43, 45-47 recite a "switching computer means being capable of **disallowing completion of a call through the switching station** if it is determined...that the call is not placed by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone

number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the "switching computer means being capable of disallowing completion of a call through the switching station if it is determined...that the call is not placed by a caller in good standing" as recited in claims 29, 31-33, 35-37, 39, 41-43, 45-47 since in applicant's system, the call is completed through the switching facilities (communication facility C, ACD, switch 21) irrespective of the caller's standing.

Claims 38 and 48 recite "**preventing connection of telephone calls** if validation determines the call is not made by a caller in good standing." Applicant's specification fails to provide support for this feature. In applicant's system, a caller dials the telephone number and is coupled by the communication facility through the ACD, interface and switch to a select processor. It is only after the call has been completed from the caller through the switching facilities to the select processor that the caller is determined as being one of good standing (page 12, line 14 - page 13, line 27; page 20, line 24 - page 22, line 35). If the caller is not one in good standing, the completed call is terminated (page 13, lines 28-31). Therefore, applicant's specification does not provide support for the step of "**preventing connection of telephone calls** if validation determines the call is not made by a caller in good standing."

Applicant's disclosure fails to provide support for performing a "repeated failed attempts determination" and "preventing repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time" as recited in claims 31 and 41. Applicant's system provides for a use-rate calculator for determining and limiting the number of successful uses by a caller, not the number of failed attempts.

Applicant's disclosure does not provide support for "a data storage server means...capable of access by card customers of the telephone system to provide current billing information to card customers" as recited in claims 32 and 42 or "a voice response means being...capable of providing an oral report of current account status to card users" as recited in claims 33 and 43.

4. Claims 29, 31-33, 35-39, 41-43, 45-48 of this application are asserted by applicant to correspond to claims of U.S. Patent No. 5,790,636.

The examiner does not consider these claims to be directed to the same invention as that of U.S. Patent No. 5,790,636 because it does not contain all the material limitations of the patent claim as required by 35 USC 135 (b), namely, the use of a travel card for controlling the telephone system. Accordingly, an interference cannot be initiated based upon these claims.

5. Claims 29, 31-33, 35-39, 41-43, 45-48 of this application has been essentially copied by the applicant from U. S. Patent No. 5,790,636. These claims are not patentable to the applicant because they are not supported by applicant's original disclosure.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

6. Applicant's arguments filed December 26, 2002 have been fully considered but they are not persuasive.

Applicant argues that the language "generally indicates a type of system...does not specify that the telephone system is controllable by cards, but rather specifies merely that the system be of a type controllable by cards." The preamble of amended claim 29 states a **"telephone system**...of a type controllable by data related to cards" not merely "a type of system" as argued by the applicant. The examiner contends that applicant's specification describes the use of a credit card to authorize a transaction, such as mail order transaction or lottery participation, which takes place over an already completed telephone connection such that applicant's card does not control a telephone system. A card having data used for controlling a telephone system or handling telephone calls, as in the travel card of Marshall and as defined by the present claims, is used to authorize telephone call completion between a caller and a desired second party. The credit card or lottery ticket of the applicant is used to authorize a mail order transaction or participation in a lottery; calls are completed to applicant's telephone-interface system without any prior qualification based on the credit card or lottery identification data.

Regarding the "disallowing recitation," Applicant argues that "[i]n the Marshall system connections to the PC 32 (computer) allow it to test for approval of an operation" and

"[s]imilarly in Applicant's specification, connections to the processors, e.g. processor PR1...allow it to test for approval." The examiner disagrees. Firstly, it is not the "disallowing" feature which is at issue. It is it the recition "disallowing **completion of a call through the switching station**." In the Marshall system, the call is received at switching station 16 which includes PC32. If PC32 determines that the caller is not in good standing (received PIN is not valid, insufficient credit balance, etc.), DCO switch 22 is instructed to not complete the call through the telephone system to the desired destination telephone number (col. 6, line 9 - col. 7, line 47). In Applicant's system, the call has already been completed through the telephone system to the processor PR1 before any testing takes place (page 12, line 14 - page 13, line 27; page 18, line 31 - page 22, line 35). Applicant's system does not disallow completion of a call through the switching station. Rather, applicant's system disallows participation by a caller in a health-related statistical analysis, lottery or mail-order operation. Applicant argues that after approval, callers "may experience the completion of a call, for example to the interface terminal IT." The examiner contends that the connection of a call to the terminal IT takes place after the call has been completed to the processing system. Applicant clearly states in his disclosure on page 21, lines 7-15 that the communication is tranferred to the interface terminal IT. Call transfer takes place after an initial call completion.

Claims 29, 31-33, 35-39, 41-43, 45-48 require that the switching computer means determine whether or not a caller is in good standing based on the processing of call data which includes <u>both</u> automatic number identification and a personal identification number. Applicant

points to the use of a credit card number (page 22, line 22), customer number (page 22, line 21), personal identification number (page 35, line 20) or a driver's license number (page 37, line 15) as providing support for a personal identification number. However, in none of these instances is the personal identification number used with automatic number identification to determine whether or not a caller is in good standing before the call is completed through the switching station.

Regarding the limitations of claims 31 and 41 which recite performing a "repeated failed attempts determination" and "preventing repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time," applicant points to pages 13 and 36 of his specification where his system determines if the caller has entered a proper telephone number within an period of time and whether a large number of calls have originated from a single telephone terminal. However, the personal identification number of dependent claims 31 and 41 is not the caller's telephone number (**note independent claims 29 and 39 which state that call data includes automatic number identification and a personal identification number**). Moreover, by definition, a personal identification number is a number specific to an individual, not a telephone station.

Regarding claim 32, applicant argues that "[t]he dependent claim 32 involves the provision of billing information as stored" and points to page 34, line 19 and page 40, line 14. However, claims 32 and 42 recite "a data storage server means...capable of access by card

customers of the telephone system to provide current billing information to card customers." Applicant's page 34, line 19 refers to providing an accounting of scores for each player at intervals or real-time, not current billing information to card customers who access the data storage server means. Applicant's page 40, line 14 refers to storing billing data. There is no mention of providing current billing information to card customers who access the data storage server means.

The limitations of claims 33 and 43 which recite "a voice response means being...capable of providing an oral report of current account status to card users." Applicant points to page 9, line 9 and page 12, line 30. However, these lines merely describe a voice prompt which cues the caller to enter a telephone number. It does not provide support for providing an oral report of current account status to card users.

Conclusion

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Any general inquiries should be directed to the Customer Service Office at (703) 306-0377.

March 24, 2003

STELLA WOO
PRIMARY EXAMINER